

7/12/01

**THIS DISPOSITION
IS NOT CITABLE AS PRECEDENT
OF THE T.T.A.B.**

Paper No. 10
EWH

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Satellite Imagery Limited

Serial No. 75/505,778

Edwin D. Schindler for Satellite Imagery Limited.

David C. Reihner, Trademark Examining Attorney, Law Office
107 (Thomas Lamone, Managing Attorney).

Before Hanak, Hohein and Rogers, Administrative Trademark
Judges.

Opinion by Hanak, Administrative Trademark Judge:

Satellite Imagery Limited (applicant) seeks to register
THE SATELLITE IMAGE BANK in typed drawing form for the
following goods and services. The intent-to-use application
was filed on June 17, 1998. At the request of the Examining
Attorney, applicant entered the following disclaimer: "No
claim is made to the exclusive right to use BANK apart from
the mark as shown."

Printed material, namely, archived photographs of
satellite images for purchase by the media, general
public, or specialist organizations, and special
satellite images, namely, satellite photographs, near
infra-red satellite photographs, infra-red satellite
photographs, radar satellite photographs, black-and-
white satellite photographs, and multi-spectral

satellite photographs in Class 16 and Information services, namely, providing a database featuring satellite photographs or satellite infrared, radar, or multi-spectral images available in printed form or accessible through the use of a computer in Class 42.

The Examining Attorney has refused registration on the basis that applicant's mark, as applied to applicant's goods and services, is merely descriptive pursuant to Section 2(e) (1) of the Trademark Act.

When the refusal to register was made final, applicant appealed to this Board. Applicant and the Examining Attorney filed briefs. Applicant did not request a hearing.

A mark is merely descriptive pursuant to Section 2(e) (1) of the Trademark Act if it immediately conveys information about a significant quality or characteristic of the relevant goods or services. In re Gyulay, 820 F.2d 1216, 3 USPQ2d 1009 (Fed. Cir. 1987); In re Bed & Breakfast Registry, 791 F.2d 157, 229 USPQ 818 (Fed. Cir. 1986). Whether a mark is merely descriptive is determined in relation to the identified goods and services, not in the abstract. In re Omaha National Corp., 819 F.2d 1117, 2 USPQ2d 1859 (Fed. Cir. 1987); In re Abcor Development Corp., 588 F.2d 811, 200 USPQ 215 (CCPA 1978).

Condensing the rather lengthy description of goods and

services, applicant seeks to register THE SATELLITE IMAGE BANK for photographs of satellite images for purchase (goods) and for providing a database featuring satellite photographs or satellite images (services). We will consider first whether applicant's mark is merely descriptive of its services. By disclaiming the word BANK, applicant tacitly conceded that this word is descriptive for both its services and its goods. In this regard, we note that at page 5 of its brief applicant states that it "can agree with the Examiner that the word BANK may be descriptive." The word "bank" is defined not only as "an establishment for receiving or lending money," but also as a "reserve supply; pool." Webster's New World Dictionary (1996). Hence, a database can be viewed as a bank or pool of data.

Thus, in its entirety the "mark" THE SATELLITE IMAGE BANK immediately informs prospective consumers of the nature of the bank, namely, that it features satellite images. The term "satellite image bank" is just as understandable as is the term "blood bank."

At pages 4 and 5 of its brief, applicant makes the following argument: "It is contended that upon viewing

Ser. No. 75/505,778

applicant's mark, or hearing it pronounced, one is forced to engage in a multi-step reasoning process before such person is even likely to realize the nature of applicant's goods and services ... In any event, one viewing or hearing applicant's trademark would almost certainly have to devote a reasonable measure of thought, conjecture and speculation in order to be able to offer an educated guess at that which is being offered by applicant under its trademark."

Applicant appears to be arguing that if a person simply saw applicant's mark THE SATELLITE IMAGE BANK by itself and was not told about the services and goods with which it is used, that person would be unable to "realize the nature of applicant's goods and services." Such is not the test for determining whether a mark is merely descriptive. As noted earlier, the mere descriptiveness of a mark is not determined in the abstract, but rather is determined in relationship to the identified goods and services. Stated somewhat differently, the pertinent inquiry is whether a relevant purchaser who is informed both of applicant's mark and of the description of applicant's goods and services would be able to readily discern any significant quality or characteristic of the goods or services.

Applying this proper test for mere descriptiveness, we have no doubt that a prospective purchaser upon being informed both of applicant's mark (THE SATELLITE IMAGE BANK) and of applicant's services (a database featuring satellite photographs or satellite images) would immediately understand that applicant's bank is a database which features satellite photographs and satellite images. Indeed, while applicant's test is not the test for mere descriptiveness, even under applicant's test we are of the view that a prospective purchaser who is informed only of applicant's mark THE SATELLITE IMAGE BANK would understand that applicant provides a bank or database featuring satellite images. In this regard, we note the following sentence appearing at page 5 of the Examining Attorney's brief: "Without being generic, a more descriptive expression [THE SATELLITE IMAGE BANK] identifying applicant's goods and services would be difficult to devise."

Turning to a consideration of whether applicant's "mark" THE SATELLITE IMAGE BANK is merely descriptive of applicant's goods (photographs of satellite images for purchase), we find that while the "mark" is not as highly descriptive of the goods as it is of the services, it

nevertheless is still merely descriptive of applicant's goods. Put quite simply, a prospective purchaser upon being informed both of applicant's "mark" THE SATELLITE IMAGE BANK and of applicant's goods (photographs of satellite images for purchase) would immediately understand an important quality or characteristic of said goods, namely, that they emanate from a bank or database containing satellite images. By way of analogy, if one saw the hypothetical "mark" THE USED CAR DEALERSHIP on a car, one would understand that the car emanated from a used car dealership. Clearly, the term "used car dealership" is generic for the services of operating a used car dealership. At an absolute minimum, the term "used car dealership" is merely descriptive of the cars (i.e. goods) which emanate from such dealerships. In similar fashion, applicant's "mark" THE SATELLITE IMAGE BANK is, at a minimum, merely descriptive of photographs of satellite images in that it immediately informs prospective purchasers that the satellite images come from a bank or database containing satellite images.

Decision: The refusal to register on the basis that applicant's mark is merely descriptive of both its goods and its services is affirmed.

